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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,278	06/27/2003	Erik W. Selberg	RN074 (2635-012-03)	8513
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Graybeal Jackson Haley c/o RealNetworks			EXAMINER	
Graybeal Jackson Haley LLP			TRUONG, THANHNGA B	
155 - 108th Ave NE Suite 350			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/608,278	SELBERG ET AL.
	<b>Examiner</b> Thanhnga B. Truong	<b>Art Unit</b> 2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 30 May 2008.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 68-86 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 68-86 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. This action is responsive to the communication filed on May 30, 2008. Claims 68-86 are pending. Claims 1-67 are cancelled, and claims 84-86 are newly added by the applicant. At this time, claims 68-86 are rejected.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 68-86 have been considered but are moot in view of the new ground(s) of rejection. New citations of the prior art also include in the office action.

In addition, applicant has argued that:

Spagna fails to disclose providing information on how to qualify for a license to use content when a request for a use of the content has been received but the authority to use the content as requested has not been established.

Examiner respectfully disagrees with the applicant and still maintain that:

Spagna does teach this limitation in column 6, lines 35-39 of Spagna. Moreover, Spagna also discloses much more in details in column 14, lines 1-47 and column 21, lines 38-49 of Spagna. Beside, claim 68 recited the language "**providing information on how to qualify for a licence**, if none of the plurality of licenses authorizes the use". The claimed terms or phrase is not used or clearly defined in the specification, which could construe indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is believed that giving a claim its broadest reasonable interpretation and reviewing the claim as a whole in light of the specification as understood by one of ordinary skill in the art are important steps in analyzing a claim for indefiniteness.

The fact that Examiner may not have specifically responded to any as indicating particular arguments made by Applicant and Applicant's Representative, should not be construed Examiner's agreement therewith.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 68 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant amended the pre-amble to include the language "determining whether or not to allow a use of digital content". It is unclear what Applicant's intended metes and bounds of the claim are, since the claim appears to cover anything and everything that does not prohibit actions from occurring.

Claims 69-86 are depended on claim 68, thus they are rejected with the same rationale applied against claim 68 above.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 68 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant amended the pre-amble to include the language "determining whether or not to allow a use of digital content". It appears that the language in the pre-amble absents recitation of any code or steps for causing a computer to do anything, instead just ensuring there's no code or steps which prohibit it, there does not appear to be a useful, concrete and tangible result. Recognize that all these claims require is that a reference does not prohibit a computer from doing the recited acts. They do not cause any functionality to occur in the computer.

Claims 69-86 are depended on claim 68, thus they are rejected with the same rationale applied against claim 68 above.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 68-72, 74, 77-86 are rejected under 35 U.S.C. 102(e) as being anticipated by Spagna et al (US 6,587,837 B1).

a. Referring to claim 68:

i. Spagna teaches a method for determining whether or not to allow a use of digital content (**column 9, lines 52-57 of Spagna**), the method comprising:

(1) defining a plurality of licenses for authorizing use of the content (**column 4, lines 27-32; column 10, lines 28-33 of Spagna**) from a configurable rules that is based at least in part on a user attributes(**column 12, lines 52-67 of Spagna**);

(2) receiving a request to use the content (**column 10, lines 28-33 of Spagna**);

(4) determining whether or not at least one of the plurality of licenses authorizes the requested use of the content (**column 10, lines 28-33; column 14, lines 1-19 of Spagna**); and

(5) providing information on how to qualify for a license, if none of the plurality of licenses authorizes the use (**column 6, lines 35-39 of Spagna**).

b. Referring to claim 69:

i. Spagna further teaches:

(1) wherein the user attributes comprise the user's age (**column 11, lines 8-17 of Spagna**).

c. Referring to claim 70:

i. Spagna further teaches:

(1) wherein the user attributes comprise the user's residence (**column 11, lines 8-17 of Spagna**).

d. *Referring to claim 71:*

i. Spagna further teaches:

(1) wherein the user attributes comprises a payment method (column 4, lines 22-26; column 11, lines 8-17 of Spagna).

e. *Referring to claim 72:*

i. Spagna further teaches:

(1) wherein at least one of the plurality of licenses comprises at least one grant (column 10, lines 28-33 of Spagna).

f. *Referring to claims 74, 84:*

i. Spagna further teaches:

(1) wherein determining whether or not at least one of the plurality of licenses authorizes the requested use comprises comparing an entitlement requirement of at least one of the plurality of licenses against an attribute of a user who has made the request (column 10, lines 28-33 of Spagna).

g. *Referring to claim 77:*

i. Spagna further teaches:

(1) wherein the requested use comprises playback (column 5, line 51 of Spagna).

h. *Referring to claim 78:*

i. Spagna further teaches:

(1) wherein the requested use comprises copying to a compact disc (column 53, lines 11-16 of Spagna).

i. *Referring to claim 79:*

i. Spagna further teaches:

(1) wherein the requested use comprises copying to a digital video disc (column 53, lines 11-16 of Spagna).

j. *Referring to claim 80:*

i. Spagna further teaches:

(1) wherein the requested use comprises copying to a hard-drive (column 53, lines 11-16 of Spagna).

k. *Referring to claim 81:*

i. Spagna further teaches:

(1) wherein the requested use comprises downloading to a portable player (**column 9, lines 58-59 of Spagna**).l. *Referring to claim 82:*

i. Spagna further teaches:

(1) wherein the rule is dynamically reconfigurable (**column 29, lines 47-50; column 31, lines 53-55; column 45, lines 22-29; column 52, lines 36-50 of Spagna**).m. *Referring to claim 83:*

i. Spagna further teaches:

(1) wherein at least one of the plurality of licenses is dynamically reconfigurable (**see Figure 5 and column 4, lines 26-32; column 39, lines 31-43 of Spagna**).n. *Referring to claim 85:*

i. Spagna further teaches:

(1) wherein providing information on how to qualify for a license comprises providing a user attribute that would allow authorization of the requested use (**column 10, lines 28-33; column 14, lines 1-19 of Spagna**).o. *Referring to claim 86:*

i. Spagna further teaches:

(1) wherein providing information on how to qualify for a license comprises providing an amount of money that, if received, would allow authorization of the requested use (**column 14, lines 20-47; column 21, lines 38-49 of Spagna**).***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 73, 75, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna et al (US 6,587,837 B1), and further in view of Eichstaedt et al (US 6,108,645).

a. Referring to claims 73, 75, 76:

i. Spagna teaches the claimed subject matter via the usage of licenses and rules. However Spagna is silent on the capability of using Boolean-based expressions with its rules. On the other hand, Eichstaedt teaches this limitation in **column 2, lines 10-18; column 8, lines 25-27 of Eichstaedt.**

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Spagna with the teaching of Eichstaedt to establish a secure, global distribution system for digital content that protects the rights of content owners (**column 2, lines 56-58 of Spagna**).

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Spagna with the teaching of Eichstaedt for the secure delivery and rights management of digital assets, such as print media, films, games, and music over global communications networks such as the Internet and the World Wide Web (**column 1, lines 55-58 of Spagna**).

**Conclusion**

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then

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the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

a. Wyman (US 5,204,897) discloses management interface for license management system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

/Thanhnga B. Truong/  
Primary Examiner, Art Unit 2135

TBT

September 11, 2008